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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/534,443

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Jeffrey L. Johanning

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EXAMINER

PATEL, ASHOK

ART UNIT

PAPER NUMBER

2879

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/534,443

Applicant(s)

JOHANNING, JEFFREY L.

Examiner

Ashok Patel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-40, 71, 72, 83 and 84 is/are pending in the application.
- 4a) Of the above claim(s) 71 and 72 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 31-38, 83 and 84 is/are rejected.
- 7) ☐ Claim(s) 39 and 40 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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1. Applicant's arguments filed 07/22/2004 have been fully considered but they are not persuasive.

2. Claims 34-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 34 recites the limitation "said stem clamp comprises a generally tubular member having two pair of frame retaining tabs". However parent claim 32 recites "said stem clamp comprising one or more frame retaining tabs". These two limitations are contradicting in that parent claims recites the clamp having one or more frame retaining tabs, whereas claim 34 recites the stem clamp having a generally tubular member, which has two pair (pairs) of frame retaining tabs. These two limitations are not consistent with each other.

Claims 35 and 36 are necessarily rejected by way of their dependencies on claim 34.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 31-38 and 83 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Brown et al (USPN 6,288,164).

Brown et al disclose applicant's claimed mounting structure (Figures 1-3) including: an elongated frame (14) supported at one end by a stem assembly (bottom part of the frame), there being no weld between the frame and the stem assembly. At col. 2, lines 51-53, note that Brown et al disclose that the weld (or welding) is a matter of preference. This clearly implies that the weld is not there always. In the entire disclosure, Brown et al do not disclose that the weld is always there.

As to claim 32, Brown et al disclose the lap including a stem (10) and a stem claim (11) supported by the stem and including one or more frame retaining tabs (element 11a, 11b, 11c or 11d).

As to claim 33, Brown et al disclose the frame including a wire (14) forming an end portion (bottom portion) and two

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substantially parallel legs extending in substantially the same direction from said end portion.

As to claim 34, Brown et al disclose the frame including a generally tubular member (11, 12) having two pairs of frame retaining tabs (11c-12d; 11d-12c), each pair of tabs being positioned opposite the other about a curved surface of the stem clamp, the tabs forming opening to receive the portion of the wire 14.

As to claim 35, Brown et al disclose frame includes wire (14) forming an end portion and two substantially parallel legs extending in substantially the same direction from the end portion (as mentioned earlier for claim 33), a portion (bottom portion as shown in Figures 1-3) of one of the legs being received through the openings formed by one pair (11c-12d) of the frame retaining tabs, a portion (bottom portion as shown in Figures 1-3) of the other of the legs being received through the openings formed by the other pair (11d-12c) of the frame retaining tabs.

As to claim 36, Brown et al disclose the tabs (c; d) each forming an aperture.

As to claim 37, Brown et al disclose the frame including a wire (14) forming and end portion (the bottom portion) and a leg

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(longer portion of element 14) extending from the end portion, the leg having a swaged portion adjacent its terminal end.

As to claim 38, Brown et al disclose the stem clamp including a generally tubular member (as mentioned earlier for claim 34).

As to claim 83, Brown et al disclose the stem assembly including: a stem (9) and a stem clamp (11 or 12) supported by the stem, the stem clamp including: one or more end by engagement with one or more of the frame retaining tabs (a-d located at each corners area).

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 84 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brown et al (USPN (6,188,164) in view of Gustin (USPN 3,094,640).

Brown et al disclose the mounting structure wherein the frame includes a pair of substantially parallel elongated legs (14a, 14b), each of the legs having a tab retaining portion

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(14c) adjacent the terminal end thereof. However, Brown et al do not disclose the structure including a heat shield as claimed by applicant.

Although providing the heat shield is known in the art of arc tube mounting structure, Gustin is cited for teaching a lamp including a heat shield (30) for shielding a heat emitted from a lighting source.

Consequently, it would have been obvious to one of ordinary skill in the art to provide Brown et al's lamp including the heat shield as taught by Gustin suitably for shielding the heat emitted from the lighting source.

7. Claims 39 and 40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Prior art of the record does not disclose applicant's lamp of claim 39 (which includes all limitations recited in intervening claims 31, 32 and 38) wherein one of the tabs forms an aperture and other of the tabs forms a slot.

8. The Examiner replies to applicant's arguments as follows.

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At page 6 of his response (filed on 07/22/2004), applicant argues about claims 81 and 82 in that these claims are generic to elected species I. It appears that applicants meant to refer to claims 71 and 72 instead of claims 81 and 82 since claims 81 and 82 are cancelled in the application.

As to claims 71 and 72 (which belong to Species VII), these claims are not generic to species I. Species I includes "a structure specifically reciting no weld between a frame and a stem assembly". Claims 71 and 72 (Species VII) are directed to "a structure specifically reciting a frame, and a stem assembly having a stem and a heat shield". Thus scope of Species VII (claims 71 and 72) is different from that of species I (claim 31). The Examiner voluntarily included claim 84 into the elected species (Species I) solely on the basis of its dependency on claim 31 (see last office action, paper no. 0404, page 2, lines 5-7). Solely because claim 84 depends on claim 31, claim 84 recites a structure including "no weld between a frame and a stem assembly" and therefore included into the elected Species (Species I). In the last office action, the Examiner could have taken a position to withdraw claim 84 from consideration since it is directed to a structure that is covered in non-elected Species VII.

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If claims 71 and 72 were made dependent on claim 31 (just like claims 32+ are now amended to be dependent on elected species claim 31), then the Examiner would have considered claims 71 and 72. However since claims 71 and 72, as they stand currently, fall into Species VII and not Species I, the Examiner does not consider them and maintains the position.

As to rejection of claim 31, applicant argues that Brown et al (USPN 6,188,164) do not anticipate applicant's claims 31, 83. This is not found persuasive since, as mentioned earlier in the rejection of claim 31, Brown et al's lamp does not necessarily (always) include a weld. From the entire context of Brown et al's disclosure it becomes abundantly clear that Brown et al's lamp includes only when preferred, not always. As a matter of fact, Brown et al clearly disclose, at col. 2, lines 22-31) the lamp including two banding straps 11 and 12 as crimped.

Applicant pointed in his response that page 1 (cover sheet) of the last office action indicates that the subject application is in the condition for allowance except for formal matter and that prosecution as to the merits is closed under Ex Parte Quayle. The Examiner realized that it was his inadvertent error. The subject application was not meant to be in the condition for allowance under Ex Parte Quayle. The Examiner

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inadvertently checked the box for item no. 3 on the cover sheet. The Examiner apologizes for this mistake.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ashok Patel whose telephone number is 571-272-2456. The examiner can normally be reached on Monday-Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nimesh Patel can be reached on 571-272-2457. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Ashok Patel
Primary Examiner
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